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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/618,154

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M. Scott Reichardt

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ROPES & GRAY LLP

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EXAMINER

NGUYEN BA, HOANG VU A

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/618,154	<b>Applicant(s)</b> REICHARDT ET AL.	
	<b>Examiner</b> Hoang-Vu A. Nguyen-Ba	<b>Art Unit</b> 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 85-140 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 85-140 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/17/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 17, 2009 has been entered.
2. Claims 85-140 are pending. Claims 85, 98, 111 and 124 are independent claims.

### ***Information Disclosure Statement***

3. The Office acknowledges receipt of the Information Disclosure Statements filed on February 17, 2009. It has been placed in the application file and the information referred to therein has been considered.

### ***Response to Amendments***

4. Per Applicants' request, Claims 85, 98, 111 and 124 have been amended and new claims 137-140 have been added.

### ***Response to Arguments***

5. Applicants' arguments have been fully considered but they are moot in view of the new grounds of rejection.

### ***Claim Rejections – 35 USC § 103***

6. The following is a quotation of the 35 U.S.C. § 103(a) which form the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 85-94, 98-107, 111-120, 124-133 and 137-140 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO98/53611 by Ten Kate in view of U.S. Patent No. 6,177,931 to Alexander et al. (“Alexander”).

It should be noted that hereinafter the use of the clause “see at least” should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant’s arguments should not therefore be considered to be that of new grounds of rejection.

### **Claim 85**

Ten Kate discloses at least *a method for presenting a user with a graphic advertisement in an interactive television program guide implemented on user television equipment, wherein television commercials and other television programming are transmitted to the user television equipment over a communications path from a distribution facility and are displayed for the user on the user television equipment, comprising:*

*displaying, without entering a page of additional information, a full-screen television program (see at least FIG. 7);*

*providing the user with an opportunity to access additional information about a current event in a television program information by overlaying, without entering a web page, an icon on the full-screen television commercial, wherein the icon indicates the availability of the additional information (see at least FIG. 7); and*

*in response to receiving a user input to access, displaying the information (see at least p.4, lines 26-34).*

Ten Kate does not specifically disclose the remaining features of the claim.

However, in an analogous art, Alexander discloses:

*an interactive television guide information (see at least FIG. 1);*

*a commercial associated with a given advertiser (see at least FIG. 1, elements 14, 16);*

*a graphic advertisement associated with the given advertiser (see at least FIG. 1, elements 14, 16).*

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Ten Kate's capability of displaying an icon to give user access to an interactive television program guide as taught by Alexander in addition to supplemental information about a subject currently displayed in full-screen mode (e.g., a commercial clip about an upcoming concert under the direction of a renown conductor such as the one shown in FIG. 7 of Ten Kate). One of ordinary skill in the art would have been motivated to modify Ten Kate in order to alert a user of the availability of interactive EPG where the user would have the possibility to set his/her VCR/PVR to record the concert when the concert is broadcast. Without this possibility, the user would have been unaware of the availability of accompanying EPG or Web page relating to a commercial of interest to the user (Ten Kate, Background of the Invention).

#### **Claim 98**

Claim 98 is an independent claim that recites a system (Ten Kate, FIG. 1 or Alexander, e.g., the television systems mentioned in 1:36-40) comprising means for performing the steps of the method claim 1. Thus, the rationale for the rejection of Claim 1 also applies to Claim 98.

#### **Claim 111**

Ten Kate discloses at least *a system for presenting a user with a graphic advertisement in an interactive television program guide* (Ten Kate, FIG. 1) *comprising:*

*a display device* (Ten Kate; see at least FIG. 1, element 23);

*an input device* (see at least FIG. 1, element 28); and

*control circuitry* (Ten Kate; FIG. 1, element 2) *configured to perform the steps of the method claim 1.* Thus, the rationale for the rejection of the claim discussed in claim 1 is deemed applicable to claim 111 regarding the above features.

Ten Kate does not specifically disclose:

*an interactive television guide information* (see at least FIG. 1);

*a commercial associated with a given advertiser* (see at least FIG. 1, elements 14, 16);

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*a graphic advertisement associated with the given advertiser (see at least FIG. 1, elements 14, 16).*

However, in an analogous art, Alexander discloses the above features in FIG. 1 (see claim 1).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Ten Kate's capability of displaying an icon to give user access to an interactive television program guide as taught by Alexander in addition to supplemental information about a subject currently displayed in full-screen mode (e.g., a commercial clip about an upcoming concert under the direction of a renown conductor such as the one shown in FIG. 7 of Ten Kate). One of ordinary skill in the art would have been motivated to modify Ten Kate in order to alert a user of the availability of interactive EPG where the user would have the possibility to set his/her VCR/PVR to record the concert when the concert is broadcast. Without this possibility, the user would have been unaware of the availability of accompanying EPG or Web page relating to a commercial of interest to the user (Ten Kate, Background of the Invention).

#### **Claim 124**

Claim 124 is an independent that recites *a computer readable medium encoded with machine-readable instructions (Ten Kate; FIG. 1, element 24) for use in performing the same steps of the method claim 1*. Thus, the rejection of Claim 1 also applies to Claim 124.

#### **Claims 86, 99, 112 and 125**

The rejection of respective base claim is incorporated. The combination Ten Kate-Alexander further discloses *wherein the television commercial and the graphic advertisement are both branded with the same brand, the method further comprising displaying the graphic advertisement branded with that brand on the user television equipment (Alexander; see at least FIGs. 10A-B; display of additional information concerning subject matter of a highlighted panel Ad window with brand or logo such as ABC® and CBS®'s logo).*

**Claims 87, 100, 113 and 126**

The rejection of respective base claim is incorporated. The combination Ten Kate-Alexander further discloses *retrieving the graphic advertisement from local memory* (Alexander; see at least 4:34-43; 33:45-46; 34:10-16).

**Claims 88, 101, 117 and 127**

The rejection of respective base claim is incorporated. The combination Ten Kate-Alexander further discloses *retrieving the graphic advertisement from a remote server* (Alexander; see at least 8:27-43; 33:45-47; 34:10-16).

**Claims 89, 102, 114 and 128**

The rejection of respective base claim is incorporated. The combination Ten-Kate-Alexander further discloses *retrieving the graphic advertisement from local memory according to a schedule* (Alexander; see at least 25:50 – 26:60).

**Claims 90, 103, 118 and 129**

The rejection of respective base claim is incorporated. The combination Ten Kate-Alexander further discloses *retrieving the graphic advertisement from a remote server according to a schedule* (Alexander; see at least 8:18-64; 25:50 – 26:60; 33:21-24).

**Claims 91, 104, 115 and 130**

The rejection of respective base claim is incorporated. The combination Ten Kate-Alexander further discloses *retrieving the graphic advertisement from local memory in response to a real-time flag in the commercial* (Alexander; see at least 8:18-64; 14:47 – 15:31; 33:21-24; 33:21-24).

**Claims 92, 105, 119 and 131**

The rejection of base claim is incorporated. The combination Ten Kate-Alexander further discloses *retrieving the graphic advertisement from a remote server in response to a real-*

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*time flag in the commercial* (Alexander; see at least 8:18-64 and 14:47 – 15:31; 33:21-24; 33:43-47).

**Claims 93, 106, 116 and 132**

The rejection of base claim is incorporated. The combination Ten Kate-Alexander further discloses *retrieving the graphic advertisement from local memory in response to a real-time vertical-blanking-interval flag in the commercial* (Alexander; see at least 8:18-64; 33:21-24; 33:21-24).

**Claims 94, 107, 120 and 133**

The rejection of base claim is incorporated. The combination Ten Kate-Alexander further discloses *retrieving the graphic advertisement from a remote server in response to a real-time vertical-blanking-interval flag in the commercial* (Alexander; see at least 8:18-64; 14:47 – 15:31; 33:21-24; 33:43-47).

**Claims 137, 138, 139 and 140**

The rejection of the respective base claim is incorporated. The combination Ten Kate-Alexander further discloses *wherein receiving a user input comprises receiving a user selection of the icon* (Ten Kate; see at least p. 5, lines 5-6; p. 6, lines 8-10).

8. Claims 95-97, 108-110, 121-123 and 134-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO98/53611 by Ten Kate in view of U.S. Patent No. 6,177,931 to Alexander et al. (“Alexander”), as applied the respective base claim, and further in view of U.S. Patent No. 5,589,892 to Knee et al. (“Knee”).

**Claims 95, 108, 121 and 134**

The combination Ten Kate-Alexander does not specifically disclose the feature of Claims 95, 108, 121 and 134.

However, in an analogous art, Knee discloses *enabling the user to purchase a product or service using the interactive television program guide* (see at least FIGs. 43B-E and 44).



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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the feature of Knee in the combination Ten Kate-Alexander because this would provide means for a user to conveniently purchase products or services advertised in windows 14 and 16 of FIG. 1 and in highlighted windows of FIGs. 10A-B of Alexander, thereby providing users with more incentives to purchase products or services while watching television and thus increasing e-commerce.

**Claims 96, 109, 122 and 135**

The combination Ten Kate-Alexander does not specifically disclose the feature of Claims 96, 109, 122 and 135.

However, in an analogous art, Knee discloses *enabling the user to purchase a product or service using the interactive television program guide by displaying a point-of-sale window having information on the product or service in response to a user input when the icon is displayed* (see at least FIGs. 43B-E and 44).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the feature Knee in the combination Ten Kate-Alexander because this would provide means for a user to conveniently purchase products or services advertised in windows 14 and 16 of FIG. 1 and in highlighted windows of FIGs. 10A-B of Alexander, thereby providing users with more incentives to purchase products or services while watching television and thus increasing e-commerce.

**Claims 97, 110, 123 and 136**

The combination Ten Kate-Alexander does not specifically disclose the feature of Claims 97, 110, 123 and 136.

However, in an analogous art, Knee discloses *enabling the user to purchase a product or service using the interactive television program guide by displaying a point-of-sale window having information on the product or service in response to a user input when the icon is displayed, wherein the point-of-sale window also provides access to other products or services* (see at least FIGs. 43B-E and 44).

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the feature Knee in the combination Ten Kate-Alexander because this would provide means for a user to conveniently purchase products or services advertised in windows 14 and 16 of FIG. 1 and in highlighted windows of FIGs. 10A-B of Alexander, thereby providing users with more incentives to purchase products or services while watching television and thus increasing e-commerce.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:30 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2400 Group receptionist (571) 272-2400.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

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/Hoang-Vu Antony Nguyen-Ba/

Primary Examiner, Art Unit 2421

April 15, 2009